

Application No. 10/722,685  
Amendment dated February 27, 2006  
Reply to Office action of September 26, 2005

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to FIG. 6. This sheet, which includes FIGS. 5 and 6, replaces the original sheet including FIGS. 5 and 6. FIG. 6 has been amended to clarify that reference numeral 500 refers to energy application region.

Attachment: Replacement Sheet

#### REMARKS

Claims 1-25 are pending in the application after this amendment. The amendment of claims is not to be considered in any way an indication of applicant's position on the merits of the amended and/or original claims. In the following sections of the Amendment the rejections set forth by the Examiner in the September 26, 2005 Office action are addressed. These rejections are respectfully traversed, and detailed arguments are set forth below.

Applicant would like to express appreciation for the Examiner's time he spent discussing this application and the cited references.

As a first preliminary matter, applicant has changed the term "circumferencial intersection" to "rounded edge intersection" in claims where the original term appeared. At page 14, lines 12-15, the specification includes the following sentence: "The head is preferably thinner at its smooth rounded edges 210 than at its exemplary domed center 220, allowing easy insertion between tissue layers and separation of tissues as the instrument is advanced to the injury site or moved from side to side." (Emphasis added.) This quote shows that in this embodiment there are rounded edges at the front and sides of the energy application region. FIG. 6 shows an embodiment with rounded edges at the front and the back of the energy application head between the energy application region and the tissue protecting region. FIG. 5 shows an edge around the circumference of the energy application head, although it is not specifically labeled. Applicant reserves the right to return to the term "circumferencial intersection," but has amended the claims for the sole purpose of furthering prosecution. As the drawings show the smooth rounded edges 210 between the energy application region and the tissue protecting region, applicant respectfully submits that the Examiner's objection under 37 CFR 1.83(a) is now moot. Similarly, applicant respectfully submits that the Examiner's rejection under 35 USC 112, first paragraph is moot.

As a second preliminary matter, applicant has changed the term "insertion edge" to "leading edge" in claims where the original term appeared. Applicant has also

clarified that the tissue protecting region is sloped away from said energy application region. Applicant has made these amendments for the purpose of furthering prosecution, but reserves the right to file continuation applications.

As a third preliminary matter, all of the claims are subject to a double patenting rejection over issued patent (U.S. Patent No. 6,673,063). Applicant has filed a statutory disclaimer to overcome this rejection.

As a final preliminary matter, applicant respectfully requests that the references submitted on the January 7, 2005 Information Disclosure Statement (IDS) be considered and acknowledged. Applicant has verified on the PAIR Image File Wrapper that the IDS was received by the PTO on January 12, 2005.

The Examiner rejected claims 1-7 and 9-23 under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,391,028 to Fanton (the "Fanton reference"). As amended independent claims 1, 12, 16, 20, 24, and 25 all include at least one claimed limitation that is not taught or suggested by the Fanton reference, applicant respectfully submits that this rejection is moot. Further, applicant respectfully submits that the claims depending from the independent claims are allowable for the same reasons as well as for the specific structure claimed therein.

The Examiner rejected claims 1-23 under 35 USC §102(b) as being anticipated by Patent Cooperation Treaty reference No. PCT/US91/08388 to Makower (the "Makower reference"). As amended independent claims 1, 12, 16, 20, 24, and 25 all include at least one claimed limitation that is not taught or suggested by the Makower reference, applicant respectfully submits that this rejection is moot. Further, applicant respectfully submits that the claims depending from the independent claims are allowable for the same reasons as well as for the specific structure claimed therein.

The Examiner rejected claims 1-23 under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,569,242 to Lax et al. (the "Lax reference"). As amended independent claims 1, 12, 16, 20, 24, and 25 all include at least one claimed limitation that is not taught or suggested by the Lax reference, applicant respectfully submits that this rejection is moot. Further, applicant respectfully submits that the

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claims depending from the independent claims are allowable for the same reasons as well as for the specific structure claimed therein.

The Examiner rejected claims 1-7, 9, and 11-25 under 35 USC §102(b) as being anticipated by U.S. Patent No. 6,929,640 to Underwood et al. (the "Underwood reference"). As amended independent claims 1, 12, 16, 20, 24, and 25 all include at least one claimed limitation that is not taught or suggested by the Underwood reference, applicant respectfully submits that this rejection is moot. Further, applicant respectfully submits that the claims depending from the independent claims are allowable for the same reasons as well as for the specific structure claimed therein.

In view of the above, it is submitted that the currently pending claims are patentable. Accordingly, the Examiner is requested to reexamine the application, to allow the claims, and to pass the application on promptly to issue.

A Petition for Extension of Time for two months is enclosed herewith. Please charge Deposit Account No. 50-2115 for any additional fees that may be required.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Karen Oster", written over a horizontal line.

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APPENDIX  
REPLACEMENT SHEET